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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,148	03/30/2004	Bobby Patrick Ramirez	2292.01	5426
32603	7590	08/19/2005	EXAMINER	
E. RANDALL SMITH, PC 2777 ALLEN PARKWAY SUITE 800 HOUSTON, TX 77019			LAYNO, BENJAMIN	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/813,148	Applicant(s) RAMIREZ, BOBBY PATRICK	
	Examiner Benjamin H. Layno	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) 10-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 10-21, drawn to method of play, classified in class 273, subclass 292.
 - II. Claims 1-9, drawn to game apparatus, classified in class 273, subclass 297.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus cards can be used to as educational flash cards in teaching students the buying and selling in business.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Randall Smith on 08/09/05 a provisional election was made with no indication of traverse to prosecute the invention of the game apparatus, claims 1-9. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 10-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings Required

5. There are no drawings. According to 37 CFR 1.83(a), every feature mentioned in the claims must be shown in the drawings. Therefore, **drawing are required**, and the drawings must show the "Shop" cards, "Product" cards, "Account" cards, "Problem" cards "Problem Removal" cards, "Hand Over" cards "Protection" cards, "Pay Off" cards, "simulated product is drugs". These cards must be shown or the feature(s) canceled from the claim(s). **No new matter should be entered.**

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 and 5-9 rejected under 35 U.S.C. 102(b) as being anticipated by Caines.

The patent to Caines discloses a game involving the sale of product (property) for value (\$) and accumulation of value from simulated sale, page 3, lines 44-46. The game is played by a plurality of players with a plurality of cards. The game comprises a first plurality of cards, "improvement cards" Figs. 4A – 4F, representing a player's ability

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to sell products for value, wherein a property must be improved with an improvement card to increase the value of the property and increasing player's ability to sell the product (property). A second plurality of cards, property cards Figs. 3A – 3F represent one or more simulated products having value. A third plurality of cards, money Fig. 6A – 6B, represent one or more simulated depository "Bank Of Prosperity" for simulating the safekeeping of value obtained. A fourth plurality of cards, "Removal Cards" Fig. 4G, represent problems hindering a player's ability to sell the product (property), page 7, lines 43-47. A fifth plurality of cards having the directions "You may improve a property already on the market by attaching a further improvement card" Fig. 5C, removes the problem represented by the fourth plurality of cards. A sixth plurality of cards having the directions "You may purchase a property displayed in an opponents window at market price" Fig. 5C, causes a first player to obtain to a product (property) card from a second player. A plurality of seventh cards have the direction "Pay Surveyor's fees of \$4000", "Pay bank interest of \$5000", etc. Fig. 5D, which players must follow. An eight plurality of cards having the directions "Go On Holiday miss your next throw" Fig. 5A, causes a player to skip the next turn. A ninth plurality of cards "Devaluation Cards" Fig. 4H, caused the reduction of a player's recorded score, page 7, lines 48-60.

Printed Matter

8. The only difference between "Shop" cards, "Product" cards, "Account" cards, "Problem" cards "Problem Removal" cards, "Hand Over" cards "Protection" cards, "Pay Off" cards, "simulated product is drugs" of the claimed invention, and Caines' cards

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recited above resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

In *Gulack*, the Court concluded that the claimed printed matter should be given patentable weight because there was a functional relationship between the printed matter and the substrate, in that the printed matter was an endless sequence of digits and the substrate was an endless band, such that the band “presented the digits as an endless sequence with no discrete beginning or end.” *Gulack*, 703 F.d. at 1382, 217 USPQ2d at 402. By contrast, in the present case, there is no functional relationship between the substrate (cards) and the matter in question (“Shop”, “Product”, Account”, “product is drugs” etc.) printed on it. The cards in the present case merely serves the same purpose as Caines’ cards, namely, it provides a substrate or support for the indicia such that the indicia can be displayed for the convenience of the players. Therefore, the printed matter (“Shop”, “Product”, Account”, “product is drugs” etc). recited in claims 2 and 6 do not patentably distinguish cards in the present invention from Caines’ cards proposed by the Examiner.

Game Rules In Apparatus Claims

9. In claim 1, the recitations “whereby a player must play at least one of said first play at least one of said first plurality of cards to be able to simulate the sale of a product”, “whereby a player must play at least one of said third plurality of cards to simulate the accumulation of value from the simulated sale of product”, “whereby when at least one of the fourth plurality of cards is played against....”, “whereby a player can

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remove the at least one simulated problem.....", are all rules of play. Furthermore, in claim 3, "wherein at least one of said second plurality of cards is placed with one of said first plurality of cards....", and "wherein a second player may play at least one among a sixth plurality of cards against the first player to cause...." are all rules of play. Most of claims 4-9 recite rules of play. In game apparatus claims, only the claimed elements having physical structure, (e.g. first plurality of cards, second plurality of cards, etc.) are given patentable weight. Game rules, however, have no physical structure per se. Thus, **game rules have no limiting affect in game apparatus claims.**

Conclusion

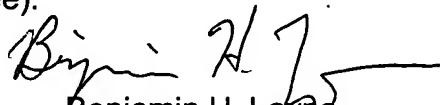
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Kaiser, Darrow, and Terrilli disclose games having cards wherein players buy and sell products.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin H. Layno
Primary Examiner
Art Unit 3711

bhl